

REMARKS

Claims 1-30 have been cancelled.

Claim 31-44 have been rejected.

No claims have been allowed.

Claim 45 and Claim 46 have been withdrawn from consideration.

Claim 47 and Claim 48 have been added.

Claims 31-44 and Claims 47-48 remain in the application.

Reconsideration of the claims is respectfully requested.

35 U.S.C. §132(a) provides, in pertinent part, that “No amendment shall introduce new matter into the disclosure of the invention.” The Examiner objected to the Applicant’s Amendment of December 13, 2001 (received by the Patent and Trademark Office on December 26, 2001) for allegedly adding new matter. Specifically, the Examiner asserted that “The added material which is not supported by the original disclosure is as follows: the description of Figures 10, 11; the disclosure running from line 21 on page 22 through the end of page 25 of substitute specification; and newly submitted Figures 10 and 11. Applicant is required to cancel the new matter in the reply to this Office Action.” (Page 2, Office Action dated April 5, 2002).

**The Allegedly New Matter Was Present in the Original Patent Application
by Incorporation by Reference from United States Patent No. 5,354,331. The
Incorporation by Reference is on Page 9, Lines 3-5 of the Original Specification.**

The allegedly new matter was present in the original patent application by the incorporation by reference of United States Patent No. 5,354,331 to *Schachar* dated October 11, 1994. (Page 9, Lines 3-5 of Original Specification) (Page 10, Lines 11-13 of Substitute Specification). The present patent application is a continuation of co-pending United States Patent Application Serial No. 09/032,830 filed on March 2, 1998 (the “‘830 Application”). The ‘830 Application is a continuation-in-part of then co-pending United States Patent Application Serial No. 08/462,649 filed June 5, 1995, now United States Patent No. 5,722,952 (the “‘649 Application”). The ‘649 Application was a co-pending divisional of United States Patent Application Serial No. 08/139,756, filed, October 22, 1993, now U.S. Patent No. 5,489,299 (the “‘756 Application”). The ‘756 Application was a co-pending divisional of United States Patent Application Serial No. 07/913,486, filed on July 15, 1992, now United States Patent No. 5,354,331 (the “‘486 Application”). The ‘830 Application also incorporated by reference the ‘486 Application, now United States Patent No. 5,354,331, into the body of the ‘830 Application.

The Applicant respectfully asserts that Figure 10 and Figure 11 clarify the original disclosure but do not add new matter. The matter disclosed in Figure 10 and Figure 11 is supported by the material incorporated by reference from United States Patent No. 5,354,331 to *Schachar*. In particular, the allegedly new matter (i.e., description of figures 10, 11; the disclosure running from line 21 on page 22 through the end of page 25 of substitute specification; and newly submitted

figures 10 and 11) is supported by the text of United States Patent No. 5,354,331 to *Schachar* from Column 7, Line 43 through Column 8, Line 45. This portion of United States Patent No. 5,354,331 clearly describes the concept of using laser radiation to weaken the sclera of the eye in the region overlying the ciliary body in order to increase the effective working distance of the ciliary muscle of the eye.

The Applicant respectfully submits that no new matter has been added to the patent application by the Amendment of December 13, 2001. The Applicant therefore also respectfully submits that the Amendment of December 13, 2001 is not objectionable under 35 U.S.C. §132. The Applicant respectfully requests that the Examiner reconsider the requirement to cancel the allegedly new matter. The Applicant respectfully requests the Examiner to withdraw the requirement to cancel the allegedly new matter.

On Page 2 of the April 5, 2002 Office Action the Examiner rejected Claims 31-44 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 4,391,275 to *Fankhauser et al.* (hereafter "*Fankhauser*"). Applicant respectfully traverses this rejection by the Examiner. The *Fankhauser* patent does not disclose the use of a laser to weaken the sclera of an eye in the region of the ciliary body with laser irradiation in order increase the effective working distance of the ciliary muscle of the eye. Therefore the *Fankhauser* patent does not anticipate Applicant's invention. The Applicant respectfully requests that the Examiner withdraw the rejection of Claims 31-44 as allegedly being anticipated by the *Fankhauser* patent.

The Applicant has added new Claim 47 and new Claim 48 to more particularly claim the method of the present invention. The Applicant respectfully requests that Claims 31-44 and Claims 47-48 be allowed.

SUMMARY

The Applicant believes that this Application is in condition for allowance. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting prosecution of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: Dec. 23, 2002



William A. Munck
Attorneys for the Applicant
Registration No. 39,308

P.O. Drawer 800899
Dallas, Texas 75380
Tel: (972) 628-3600
Fax: (972) 628-3616
e-mail: *wmunck@davismunck.com*

APPENDIX A

CHANGES IN THE SPECIFICATION

The statement on Page 1 has been amended as follows:

This application is a continuation of prior U.S. Application Serial No. 09/032,830 filed on March 2, 1998, which [This application] is a continuation-in-part of copending application Serial No. 08/462,649 filed June 05, 1995, now U.S. Patent No. 5,722,952, which is a divisional of U.S. application Serial No. 08/139,756, filed, October 22, 1993, now U.S. Patent No. 5,489,299, which is a divisional of U.S. application Serial No. 07/913,486, filed on July 15, 1992, now U.S. Patent No. 5,354,331.

CURRENT VERSION OF THE CLAIMS

1. through 30. (Cancelled)

31. (Unchanged) A laser operable to weaken the sclera of an eye in the region of the ciliary body with laser irradiation to thereby increase the effective working distance of the ciliary muscle of the eye.

32. (Unchanged) The laser set forth in Claim 31 operable to weaken the sclera of the eye in the region of the ciliary body by abrading the sclera with laser irradiation.

33. (Unchanged) The laser set forth in Claim 31 operable to weaken the sclera of the eye in the region of the ciliary body by ablating the sclera with laser irradiation.

34. (Unchanged) The laser set forth in Claim 31 operable to weaken the sclera of the eye in the region of the ciliary body by incising the sclera with laser irradiation.

35. (Unchanged) The laser set forth in Claim 31 operable to weaken the sclera of the eye in the region of the ciliary body by incising the sclera at select angles with laser irradiation.

36. (Unchanged) The laser set forth in Claim 31 operable to weaken the sclera of the eye in the region of the ciliary body by decomposing partially collagen fibers in the sclera.

37. (Unchanged) The laser set forth in Claim 31 wherein said laser is one of a carbon dioxide laser, a helium-neon laser, a helium-cadmium laser, an argon ion laser, a krypton ion laser, a xenon laser, a nitrous oxide laser, iodine laser, a holmium doped yttrium-aluminum garnet laser, an excimer laser, a chemical laser, a harmonically oscillated laser, a dye laser, a nitrogen laser, a neodymium laser, an erbium laser, a ruby laser, a titanium-sapphire laser and a diode laser.

38. (Unchanged) The laser set forth in Claim 31 wherein said laser uses one of ionizing radiation and non-ionizing radiation to weaken the sclera of an eye in the region of the ciliary body, thereby increasing the effective working distance of the ciliary muscle of the eye.

39. (Unchanged) The laser set forth in Claim 31 operable to increase the amplitude of accommodation of the eye.

40. (Unchanged) A method of operating a laser to treat one of presbyopia, hyperopia, primary open angle glaucoma and ocular hypertension, said method comprising the step of irradiating the sclera of an eye in the region of the ciliary body to thereby weaken the sclera of the eye and increase the effective working distance of the ciliary muscle of the eye.

41. (Unchanged) The method of operation set forth in Claim 41 wherein said step of irradiating the sclera of the eye in the region of the ciliary body further comprises the step of abrading the sclera with laser irradiation.

42. (Unchanged) The method of operation set forth in Claim 41 wherein said step of irradiating the sclera of the eye in the region of the ciliary body further comprises the step of ablating the sclera with laser irradiation.

43. (Unchanged) The method of operation set forth in Claim 41 wherein said step of irradiating the sclera of the eye in the region of the ciliary body further comprises the step of incising the sclera with laser irradiation.

44. (Unchanged) The method of operation set forth in Claim 41 wherein said step of irradiating the sclera of the eye in the region of the ciliary body further comprises the step of decomposing partially collagen fibers in the sclera.

45. (Withdrawn) A method for increasing the amplitude of accommodation of an eye, the eye having a crystalline lens, a ciliary muscle and a sclera, said method comprising the step of weakening the sclera through laser irradiation in the region of the ciliary body of the eye thereby increasing the effective working distance of the ciliary muscle.

46 (Withdrawn) A method for increasing the amplitude of accommodation an eye, the eye having a crystalline lens, a ciliary muscle and a sclera, said method comprising the step of weakening the sclera through one of incising and ablating the sclera in the region of the ciliary body of the eye thereby increasing the effective working distance of the ciliary muscle.

47. (New) A method for increasing the amplitude of accommodation of an eye, the eye having a crystalline lens, a ciliary muscle and a sclera, said method comprising the steps of:
applying laser irradiation in a region of the ciliary body of the eye; and
weakening said sclera with said laser irradiation in said region of the ciliary body of the eye thereby increasing an effective working distance of the ciliary muscle to increase the amplitude of accommodation of said eye.

48. (New) A method as claimed in Claim 47 wherein said step of weakening said sclera with said laser irradiation in said region of the ciliary body of the eye further comprises one of:
incising the sclera with said laser irradiation in said region of the ciliary body of the eye; and
ablating the sclera with said laser irradiation in said region of the ciliary body of the eye.